

REMARKS

New claim 19

Applicant submits new claim 19, which is like claim 1 but with the additional limitation that information concerning a selected object be communicated to a user of the portable device.

As best understood, the Examiner regards

- a video display as being an “object”, and
- “information concerning a selected object” as being the video ID and the synchronization code.

In *Fitzsimmons*, the video ID identifies a particular audio track that corresponds to a video display; the synchronization code identifies a particular location on that audio track. The *Fitzsimmons* portable device 300 uses the video ID and synchronization track (i.e., the “information concerning a selected object”) to retrieve the file containing the audio track and to start playing at the correct part of the file. This synchronizes audio playback with the video display.

In *Fitzsimmons*, the “information” that is ultimately communicated to the user is neither the video ID nor the synchronization code. In fact, it is the audio track itself. The video ID and synchronization code are communicated *to the portable device*, but they *go no further*. Neither the video ID nor the synchronization code are ever actually communicated to the user.

It is apparent therefore that *Fitzsimmons* fails to disclose the limitation of actually communicating the “information concerning the selected object” (i.e., the video ID and synchronization code) to the *user* of the portable device, as recited in claim 19.

Flom likewise fails to disclose the foregoing limitation. Therefore, even if one were to combine *Fitzsimmons* with *Flom*, the result would still fail to meet the limitations of claim 19.

Section 103 rejection of claim 11

The Examiner summarily rejects independent claim 11 by asserting that it recites limitations similar to claim 1.

In fact, claim 11 recites limitations that are quite different from those of claim 1.

For example, claim 11 recites transferring the object identity code to the central server via a wireless connection. No such limitation appears in claim 1. In fact, claim 1 makes no mention of such codes.

Claim 11 also recites retrieving requested information from a database of the central server based on this object identity code. Again, no such limitation is in claim 1.

In addition, claim 11 recites presenting, on the display, the information that was retrieved. Again, no such limitation is in claim 1.

Applicant submits that this summary rejection of the claim 11 is inconsistent with Rule 1.104(b), which requires that the Examiner's action be complete as to all matters. Applicant further submits that this summary rejection is inconsistent with Rule 1.104(c)(2), which requires that "when a reference is complex...the particular part relied on must be designated as nearly as practicable" and that "the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified."

Section 103 rejection of claim 13

Applicant draws attention to independent claim 13's limitation of causing a machine to "display the information *for a user* of a portable device."

As best understood from remarks made in connection with claim 1, the Examiner considers claim 13's "information concerning an object" to be the video ID and synchronization code. However, as discussed in connection with claim 1, neither the video ID nor the synchronization code are ever actually displayed *to the user*.

In fact, in *Fitzsimmons*, the information that is ultimately “displayed” to the user (i.e., the audio track) is never even received from the central server. It is stored on a hard drive 336 local to the portable device 300 itself.

Flom fails to remedy the foregoing deficiency in the teaching of *Fitzsimmons*. Accordingly, the proposed combination of *Fitzsimmons* and *Flom* fails to disclose all the elements of claim 13.

Section 103 rejection of claim 15

Independent claim 15 has limitations similar to claim 13. Accordingly, claim 15 is patentable for at least the same reasons as set forth in connection with claim 13.

Section 103 rejection of claim 1

The Examiner agrees that *Fitzsimmons* fails to disclose transmission of “data concerning a selected object” to the particular portable device “via the wireless communication unit.”

Instead, the *Fitzsimmons* system transmits “data concerning a selected object” to an exhibit server 444. The exhibit server decodes the “data concerning a selected object” and sends it to an IR transmitter 434, which then transmits it to the portable device 300.¹

To correct this deficiency in the teaching of *Fitzsimmons*, The Examiner proposes

“to incorporate the portable internet device of *Flom* in *Fitzsimmons* such that to have the transmission of the data to the portable device is done via wireless communication unit.”²[sic]

In other words, the Examiner appears to propose replacing the *Fitzsimmons* portable device 300 with that disclosed by *Flom*.

However, the limitation that *Fitzsimmons* fails to teach is a limitation on the *central server*, and *not* the portable device. Replacing the *Fitzsimmons* portable device with the *Flom* portable device would have no effect on what *Fitzsimmons* teaches about its central server. Therefore, the proposed combination of references would *still* result in a central server that fails

¹ *Fitzsimmons*, paragraphs 56-57

² *Office Action*, page 4, lines 6-9.

to disclose transmission of “data concerning a selected object” to the particular portable device “via the wireless communication unit.”

Moreover one of ordinary skill in the art would see no need to incorporate the portable internet device of *Flom* to achieve wireless communication. Instead, one of ordinary skill in the art would easily recognize, upon inspecting FIG. 3 of *Fitzsimmons*, that the *Fitzsimmons* portable device 300 *already* achieves wireless communication. In particular, one of ordinary skill in the art would notice that the *Fitzsimmons* portable internet device 300 *already* includes an RF receiver 348 and various processing elements typically used for wireless internet access.

The Examiner provides two reasons for why one of ordinary skill in the art would modify *Fitzsimmons* by incorporating the *Flom* portable internet device. First, the Examiner states that

“both *Flom* and *Fitzsimmons* teach invention related to portable devices providing multimedia content to users”³

Next, the Examiner states that

“having the portable Internet device having the wireless Internet access capabilities as the portable device of *Fitzsimmons* would allow user to retrieve a wider range of information provided via the Internet.”⁴

According to *Ex parte Clapp*,

“To support a conclusion that the claimed invention is directed to obvious subject matter, *either* the references must expressly or impliedly suggest the claimed invention *or* the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references”⁵ [emphasis supplied]

Since the Examiner has not attempted to identify any suggestion in the references themselves to support the proposed combination, any suggestion must be based on “a convincing line of reasoning” as required by *Clapp*.

³ *Office Action*, page 4, lines 9-11.

⁴ *Office Action*, page 4, lines 13-15.

⁵ *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Interf. 1985).

The Examiner's first observation, namely that "both *Flom* and *Fitzsimmons* teach invention related to portable devices providing multimedia content to users," suggests that the two references are in the same general field of endeavor. But saying two references are in the same general field hardly amounts to a "convincing line of reasoning" for combining those references.

The Examiner's second observation, namely that "having the portable Internet device having the wireless Internet access capabilities as the portable device of *Fitzsimmons* would allow user to retrieve a wider range of information provided via the Internet," is hardly a "convincing line of reasoning" to combine the references, particularly when: (1) the *Fitzsimmons* device 300 *already* includes wireless functionality; and (2) the *Fitzsimmons* system *already* provides internet access.⁶

Dependent claims

All dependent claims are allowable for at least the same reasons as the independent claims from which they depend.

In addition, selected dependent claims are patentable for reasons in addition to those recited in connection with the independent claims from which they depend. Among these dependent claims are those discussed below.

Section 103 rejection of claim 4

Claim 4 recites "processing circuitry configured to ...present the information [concerning an object] to a user."

As best understood, the Examiner regards the "information concerning an object" to be the video ID and synchronization code. However, neither the video ID nor the synchronization code is ever presented *to the user*. One can easily imagine a user's puzzled reaction to the question

⁶ *Fitzsimmons*, see server 570 in FIG. 5 and accompanying text.

“What video ID and synchronization code did you observe?”

The user would simply have no idea what a “video ID” or “synchronization code” might be. This is because although the video ID and the synchronization code were in fact *used to retrieve and play* the audio file, their use ended there. They were never presented to the user. It was the *audio file* that was presented to the user, *not* the video ID, and *not* the synchronization code.

Section 103 rejection of claim 10

Claim 10 recites “causing a terminal client to...present the obtained information.”

The Examiner appears to regard the synchronization code and video ID collectively being “the obtained information.” However, although this information is used to retrieve the audio track from the local hard drive of the *Fitzsimmons* portable device 300, it is not actually presented. It is the audio track that is presented.

Section 103 rejection of claims 13 and 15

Claims 13 and 15 both recite transmitting an object identification code to a central server.

The Examiner has identified the claimed “central server” with the A/V server 452. However, it does not appear that the A/V server 452 receives any sort of object identification code. Hence, the limitations of claim 13 are not met.

Moreover, to the extent that the video source ID disclosed in *Fitzsimmons*, paragraph 56 is considered to be “information concerning the object,” that information is never displayed. Instead, it is used to synchronize video with audio. Accordingly *Fitzsimmons* fails to disclose the “display” steps recited in both claims 13 and claim 15. Claims 13 and 15, and their respective progeny, are therefore allowable over the cited art.

Summary

That Applicant has advanced only certain grounds for patentability is not intended as an admission that no other grounds of patentability exist.

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Page : 13 of 13

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Now pending in this application are claims 1-19, of which claims 1, 11, 13, 15, and 19 are independent. Accordingly, a fee is due for an additional independent claim. Please charge that fee, and any other necessary fees, to our deposit account 06-1050 referencing attorney docket "12587-012001."

Respectfully submitted,

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